

Tarsha Howard

From: Dave Plummer [Dave@xeriton.com]
Sent: Monday, January 28, 2008 5:14 PM
To: Brian Brisnehan
Subject: RE: Microsoft Patent Application (MS Ref 97172.06) - Rule 131 Declaration for Signing

I think it's safe to say I'm unwilling to sign the Declaration in its current form. What are the implications for you if I don't? Can you make it by with two of the inventors?

-- Dave

From: Brian Brisnehan [mailto:BBrisnehan@bannerwitcoff.com]
Sent: Monday, January 28, 2008 2:13 PM
To: Dave Plummer
Subject: RE: Microsoft Patent Application (MS Ref 97172.06) - Rule 131 Declaration for Signing

Thanks David. Sorry for the confusion, I thought that was the mobile number I was given by someone at your house a few weeks ago but perhaps I wrote down the wrong number.

In your earlier email, you mentioned that you were uncomfortable swearing that the statements in the Declaration were true under penalty of perjury. Unfortunately, this language cannot be removed. However, to clarify, the only statements that you are declaring to be "true" are the "statements made herein of [your] own knowledge." The Patent Office understands that the inventors might not have compete and actual knowledge of every item in the Declaration. For example, with respect to statement #3, it would be possible for Microsoft to re-assign the rights under this application without an inventor's knowledge (MS has not done so in this case). That is why the Declaration only requires that the remaining statements "on information and belief are believed to be true." Similarly, the declaration states that "willful false statements" are punishable, but indicates that statements believed to be true "on information and belief" are not. With this in mind, hopefully you will now be willing to sign the Declaration.

You also stated in your email that you have nothing to substantiate the dates of conception and diligence in the Declaration. However, along with the Declaration, we provided you with Exhibit C and non-redacted Exhibit B for you to review, both of which include dates of correspondence between our firm and the MS patent departments and/or you and the other inventors. This correspondence was taken from our file for the parent application to this case, and should confirm the relevant conception and diligence dates needed for the Declaration. If you have any reason to believe that these dates might be incorrect, please let us know.

Similarly, you expressed concern about your level of expertise regarding whether conception of the claims is supported by the Exhibits. It is true that terms like "conception," "diligence," and "enablement" have specific and sometimes complex legal meanings. Fortunately, the Patent Office understands that most inventors are not trained in the precise legal meaning of these terms. Nonetheless, they ask inventors to review the claims to affirm that they do indeed describe what was invented. For example, in Exhibit B (top of page 2), before filing the application, we asked you to confirm that the draft specification and figures enabled one skilled in the art to make and use the invention. We are now asking you to review the pending claims once again. If you either do not understand the claims, or if you believe the claims go beyond what you have invented in this application, please let us know.

Hopefully this will help to clarify the attached Rule 131 Declaration. If so, please go ahead and review, sign, and return your declaration to me as soon as possible. Otherwise, if you have any other questions, or if you are still unwilling to sign the Declaration, please contact me by phone or email to discuss further.

Thanks,
 Brian

From: Dave Plummer [mailto:Dave@xeriton.com]
Sent: Monday, January 28, 2008 2:26 PM
To: Brian Brisnehan
Subject: RE: Microsoft Patent Application (MS Ref 97172.06) - Rule 131 Declaration for Signing

Not sure where you left the voicemail, but please use email.

Thanks,
 Dave

From: Brian Brisnehan [mailto:BBrisnehan@bannerwitcoff.com]
Sent: Monday, January 28, 2008 10:20 AM
To: davidba@exmsft.com; Dave Plummer; josephhmatthews@hotmail.com
Cc: Tarsha Howard; Brian Brisnehan; 003797.00923.BWMS@banneremm.com
Subject: RE: Microsoft Patent Application (MS Ref 97172.06) - Rule 131 Declaration for Signing

Hi Joe, David, and David,

Just following up on the below email regarding the Declaration under 37 CFR 1.131 that we plan to file for this patent application. I've received the signed declaration from Joe, but have not yet received it from David or David. Please review the attached declaration and exhibits and return the signed declaration to me as soon as possible. Thanks in advance, and please don't hesitate to contact me if you have any questions.

David Plummer, you emailed me with some questions and concerns about the 131 Declaration. I left a voicemail for you last week (I have your mobile # listed as 425-301-0039) but haven't heard back yet. Please let me know if there's a good time and phone number that I can reach you to answer any questions you have. Otherwise, feel free to call me at 202-824-3324.

Thanks,
 Brian

From: Brian Brisnehan
Sent: Wednesday, January 16, 2008 3:17 PM
To: 'davidba@exmsft.com'; 'dave@xeriton.com'; 'josephhmatthews@hotmail.com'
Cc: Brian Brisnehan; Tarsha Howard
Subject: Microsoft Patent Application (MS Ref 97172.06) - Rule 131 Declaration for Signing

ATTORNEY CLIENT COMMUNICATION- PRIVILEGED/CONFIDENTIAL

Re: U.S. Patent Application No.: 10/825,299
Entitled: User Friendly Remote System Interface
Our Ref.: 003797.00923

Joseph, David, and David,

Please find attached a Declaration under 37 CFR 1.131 and Exhibits A-C for each of you to review, sign, and return. As the named inventors for the Microsoft patent application entitled "USER FRIENDLY REMOTE SYSTEM INTERFACE", this declaration allows you to attest to the fact you conceived of the claimed invention prior to August 25, 1997 (the filing date of another patent application that we are trying to "swear behind"), and that you and your patent attorneys diligently pursued preparation and filing of the application during the relevant time period from August 25-27, 1997. Your attestations are supported by the evidence attached as Exhibits A-C, which include a copy of a draft application prepared by us prior to August 25, 1997, and correspondence between you and our firm to evidence the prior conception date and diligence. As you can see, we have

redacted the dates from Exhibit B, so I've attached an non-redacted copy so you can verify that these dates are in fact prior to August 25, 1997.

I think I've discussed this which each of you already (directly or indirectly), and the rest of the document should be self-explanatory, but please don't hesitate to contact me should you have any questions or comments.

We ask that you each review the attached Declaration, including Exhibits A-C. Should you agree with the statements made in the Declaration, we ask that you sign and date the Declaration and return the same to us (without the exhibits). Please return a copy of the signed Declaration to us as soon as possible by facsimile (202-824-3824), or alternatively scanning and emailing the signed document. Please note that each of you need not sign the exact same document, i.e., you can each print out a separate copy, sign and date it, and send it to us. If possible, please try to return your signed declarations to us by next Tuesday, **January 21, 2008**, so that we may prepare the filing documents and file the Declaration at the USPTO in advance of the upcoming due date.

Also, I have attached a copy of the pending claims in the patent application so that you can review the claims in connection with your review of the Declaration and Exhibits A-C.

Please let me know if you have any questions or comments, and I look forward to hearing from you soon.

Best regards,
Brian

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